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OFFICE OF PETITIONS

In re Application of :
Vernon M. Williams :
Application No. 09/511,986 :
Filed: February 24, 2000 : ON PETITION
Attorney Docket Number: :
4208US (99-0316) :

This is a decision on the Petition to Suspend the Rules Under 37 CFR 1.183, filed February 9, 2005. The petition is properly treated as a petition under 37 CFR 1.183.

The petition is **dismissed as moot**.

Background

A final rejection was mailed in the application on April 22, 2004. In response to the final rejection, Applicant filed a Request for Reconsideration on June 28, 2004, which failed to place the application in condition for allowance. Applicant was so notified in an Advisory Action, mailed July 12, 2004. Applicant then filed a Notice of Appeal on July 15, 2004, and an Appeal Brief on September 24, 2004.

In response to the Appeal Brief, the Examiner issued a non-final Office action mailed November 9, 2004, re-opening prosecution of the application and, *inter alia*, asserted new grounds for rejection.

The instant petition

Applicant responded to the non-final Office action by filing the instant petition and an appeal brief. In the instant petition Applicant asserts that the Examiner is not allowed to re-open prosecution following the filing of an appeal brief. Applicant points to 37 CFR 41.39, and avers that the Examiner is supposed

to assert new grounds for rejection in an Examiner's answer, which then presents Applicant with the option of either responding to the new ground(s) of rejection in a reply brief, or re-open prosecution.

Applicant asserts that he relied upon the three month period to reply to the Office action, rather than the two month period for responding to an Examiner's answer under 378 CFR 41.39.

Applicant requests suspension of "the new rules relating to the filing of reply briefs and the time limits for filing reply briefs be suspended, and that the Supplemental Appeal Brief filed with the instant petition be entered."

Analysis

A review of 37 CFR 41.39 and 69 Fed Reg. 49959 reveal that 37 CFR 41.39 is not exclusionary - it does not preclude the examiner from re-opening prosecution. The Federal Register provides:

> Because the current appeal rules only allow the examiner to make a new ground by reopening prosecution, some examiners have allowed cases to go forward to the Board without addressing the new arguments. Thus, the revision would improve the quality of examiner's answers and reduce pendency by providing for the inclusion of the new ground of rejection in an examiner's answer without having to reopen prosecution.

69 Fed Reg. 49959 at 49963

Contrary to Applicant's assertion, an examiner is allowed to re-open prosecution following the filing of an appeal brief. The new rule now allows the examiner to include a "new ground of rejection in an examiner's answer without having to reopen prosecution." Id. The Federal Register further emphasizes this point by adding that "[f]urthermore, if new arguments can now be addressed by the examiner by incorporating a new ground of rejection in the examiner's answer, the new arguments may be able to be addressed without reopening prosecution and thereby decreasing pendency." Id.

Here, the examiner chose to reopen prosecution and issued a non-final Office action which included a shortened three (3) month period for reply. As such, the petition to waive the new rule, which requires Applicant to respond within two (2) months to an Examiner's Answer that does not reopen prosecution, is inapplicable.

Applicant's response was timely filed.

Applicant is advised that delay resulting from the inadvertence or mistake of Applicant, or Applicant's counsel, does not warrant equitable tolling of the one month time period of 37 CFR 1.605(a). Equitable powers should not be invoked to excuse the performance of a condition by a party that has not acted with reasonable, due care and diligence. U.S. v. Lockheed Petroleum Services, 709 F.2d 1472, 1475 (Fed. Cir. 1983); Vincent v. Mossinghoff, 230 USPQ 621, 625 (D.D.C. 1985). The Office, where it has the power to do so, should not relax the requirements of established practice in order to save an applicant from the consequence of his delay. See Ex parte Sassin, 1906 Dec. Comm'r Pat. 205, 206 (Comm'r Pat. 1906) and compare Ziegler v. Baxter v. Natta, 159 USPQ 378 379 (Comm'r Pat. 1968) and Williams v. The Five Platters, Inc.,510 F.2d 963, 184 USPQ 744 (CCPA 1975).

Thus, there is no adequate showing of "an extraordinary situation" in which "justice requires" suspension of the requirements set forth in 37 CFR 1.97(d). Circumstances resulting from Applicant's, or Applicant's counsels', failure to exercise due care, or lack of knowledge of, or failure to properly apply, the patent statutes or rules of practice are not, in any event, extraordinary circumstances where the interests of justice require the granting of relief. See In re Tetrafluor, Inc., 17 USPQ2d 1160, 1162 (Comm'r Pats. 1990); In re Bird & Son, Inc. 195 USPQ 586, 588 (Comm'r Pats. 1977).

The fee for a petition under37 CFR 1.183 has increased, effective December 8, 2004, to $400.00. Applicant's deposit account has been charged an additional $270.00 as authorized in the instant petition.

This file is being referred to Technology Center 2811 for consideration by the Examiner of the Supplemental Appeal Brief filed in response to the non-final Office action, mailed November 9, 2004.

Further correspondence with respect to this matter should be addressed as follows:

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